AMENDMENT UNDER 37 C.F.R. § 1.116

Application No.: 10/091,394

Attorney Docket No.: Q68888

REMARKS

Claims 18, 19 and 20 have been amended to correctly refer to the hydrogen <u>ion</u> exponent pH as set forth in original claim 1. This was an inadvertent error and the amendment does not narrow the scope of the subject claims.

New claim 25 finds support at page 52, lines 12-18 of the specification. Claim 25 relates to measurement of the hydrogen ion exponent pH of the grease composition. As set forth in claim 25, 0.1 g of the grease is dissolved in a specific solvent at 25°C and the hydrogen ion exponent pH is measured with a pH meter.

New claim 26 finds support in Table 1 at page 50 of the specification. Claim 26 relates to the addition amount of the pH adjustor. As claimed in claim 26, the grease composition contains the pH adjustor in an amount of from 0.5 to 12% by weight.

Review and reconsideration on the merits are requested.

Claims 18-24 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Yokouchi et al., JP-A-9-169989 in view of Heimann et al., U.S. Patent No. 6,010,984 ("Heimann").

The Examiner maintains the position that a person having ordinary skill in the art, armed with the disclosure of Heimann, would have found it obvious to add a pH adjustor to the grease composition of Yokouchi in order to adjust the pH to "about 7 to about 14," and to tailor the grease to be compatible with the metal surface which contacts the grease, with a reasonable expectation of enhancing corrosion resistance.

Applicants respectfully traverse for the following reasons.

Yokouchi does not teach or a grease composition comprising a pH adjustor, as recited in Applicants' claims 18-20. On the other hand, the grease compositions of Heimann et al and

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Yokouchi sufficiently differ such that one skilled in the art would not contemplate addition of a pH adjustor to the grease composition of Yokouchi with a reasonable expectation of success. Further in this regard, Heimann et al is entirely silent with respect to application to a rolling bearing which is the subject matter of the present claims. See col. 9, lines 9-30 of Heimann et al. Application to pipes, cables and battery terminals as taught by Heimann et al does not instruct, disclose or otherwise suggest application to a rolling bearing.

Withdrawal of the foregoing rejection is respectfully requested.

Claims 18-24 remain rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Naka et al., U.S. Patent No. 5,728,659 ("Naka") in view of Heimann et al., U.S. Patent No. 6,010,984 ("Heimann") and Yokouchi et al., JP-A-90169989 ("Yokouchi").

The Examiner maintains the position that it would have been obvious to add a pH adjustor as taught by Heimann to the grease composition of Naka for the same reasons as noted above.

Applicants traverse the rejection for the same reasons as set forth with respect to the rejection over Yokouchi in view of Heimann et al. Particularly, the disclosure in Heimann et al in no manner leads one skilled in the art to employ a pH adjustor in a grease composition of a rolling bearing. Applicants do not claim a grease composition per se, but rather a rolling bearing having a grease composition sealed into the annular space formed by the rolling elements and the races. Table 5 at page 70 of the specification shows criticality in the pH of the grease in providing good durability and in retarding grease leakage.

Withdrawal of the foregoing rejection is respectfully requested.

AMENDMENT UNDER 37 C.F.R. § 1.116 Attorney Docket No.: Q68888

Application No.: 10/091,394

With respect to new claim 25, the cited references are silent with respect to the measuring

method of the hydrogen ion exponent pH. Withdrawal of all rejections and allowance of claims

18-26 is earnestly solicited.

In the event that the Examiner believes that it may be helpful to advance the prosecution

of this application, the Examiner is invited to contact the undersigned at the local Washington,

D.C. telephone number indicated below.

The USPTO is directed and authorized to charge all required fees, except for the Issue

Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any

overpayments to said Deposit Account.

Respectfully submitted,

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8